



Docket No. 1919/66766-Y-PCT-US/JPW/GJG/ACK

1626
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Francis G. Fang and Shiping Xie
Serial No.: 09/903,101 Examiner: S. Wright
Filed : July 11, 2001 Group Art Unit: 1626
For : METHOD FOR PREPARING CAMPTOTHECIN DERIVATIVES

1185 Avenue of the Americas
New York, New York 10036
May 22, 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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MAY 29 2003

TECH CENTER 1600/2900

Sir:

RESPONSE TO DECEMBER 24, 2002 OFFICE ACTION WITH TRANSMITTAL
OF TERMINAL DISCLAIMER, PETITION FOR A TWO-MONTH EXTENSION OF
TIME AND SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

This is a Response to the Office Action issued December 24, 2002 in connection with the above-identified application. A response to the December 24, 2002 Office Action was due March 24, 2003. Applicants hereby request a two-month extension of time from March 24, 2003 to May 24, 2003 for responding to the December 24, 2002 Office Action. The required fee for the two-month extension of time is \$410.00 and a check including this amount is enclosed. Therefore a response to the December 24, 2002 Office Action is now due May 24, 2003 and this Response is being timely filed.

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TERMINAL DISCLAIMER

On page 2 of the December 24, 2002 Office Action, the Examiner rejected claim 2 alleging that claim 2 is unpatentable over claim 2 of U.S. Patent No. 6,143,891 (the "'891 Patent") under the judicially created doctrine of obviousness-type double patenting.

The Examiner alleged that although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 2 encompasses the subject matter of claim 2 of the '891 Patent. The Examiner further alleged that the instant claims are both drawn to camptothecin compounds alleging that the difference between the instant claims and the claims of the '891 Patent is that the scope of the R_1 variable is more broad in the instant claims than in the '891 Patent. The Examiner alleged that one of ordinary skill in the art would be motivated to use the '891 Patent in the instant invention due to the teaching of a broad genus for R_1 in column 2, lines 40-44, and due to the species Examples 3, 4 in column 10 and Example 5 in column 11.

In response, applicants submit herewith as **Exhibit A**, a Terminal Disclaimer in connection with the above-identified application. Applicants are filing the attached Terminal Disclaimer to expedite the prosecution of the subject application without conceding the correctness of the Examiner's position. In the Terminal Disclaimer, applicants disclaim the terminal portion of the statutory term of any patent issuing from the subject application which would extend beyond the expiration date of U.S. Patent No. 6,143,891 and agree that any patent issuing from the subject application will remain commonly owned with U.S. Patent No. 6,143,891. The required fee of \$110.00 for filing the Terminal Disclaimer pursuant to 37 C.F.R. § 1.321 (b)(4) is enclosed.

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INFORMATION DISCLOSURE STATEMENT

On page 4 of the December 24, 2002 Office Action, the Examiner acknowledged receipt of the Information Disclosure Statements filed on April 26, 2002. The Examiner also stated that the references: HU P9403638; Hertzberg, R. P.; Chemical Abstracts Registry Handbook - Compound 143490-55-5; S. Sawada et al.; Fang, F. G. et al.; and Krohn, K. et al. corresponding to Exhibits 6-11 in the Information Disclosure Statement filed April 26, 2002, were not considered because the copies of the references were not found.

In response, applicants attach hereto copies of the six (6) references the Examiner did not find as **Exhibits 1-6**. Applicants also attach hereto Form PTO-1449 as **Exhibit B**, listing the six provided references. **Exhibit 1** is the Hungarian abstract corresponding to the reference submitted as Exhibit 5 to applicants' April 26, 2002 Information Disclosure Statement. Applicants request that the Examiner initial the Form PTO-1449 and return a copy of the signed form to applicants for their files.

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

In accordance with their duty of disclosure under 37 C.F.R. §1.56, applicants also direct the Examiner's attention to following disclosure which is also listed on the accompanying Form PTO 1449 (**Exhibit B**). A copy of the disclosure listed below as item 1 is attached hereto as **Exhibit 7**:

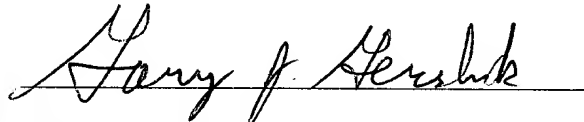
1. Japanese Patent Laid-Open Publication No. 139188/1992, including an English translation of the abstract (**Exhibit 7**).

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If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.


No fee other than the \$410.00 fee for a two-month extension and the \$110.00 fee for the filing of the Terminal Disclaimer are deemed necessary in connection with the filing of this Response. If any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Gary J. Gershik
Registration No. 39,992
Attorneys for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

 5/22/03
John P. White Date
Reg. No. 28,678
Gary J. Gershik
Reg. No. 39,992